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EXAMINER	
PHAM, TIMOTHY X	
ART UNIT	PAPER NUMBER
2617	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/595,941	WENNBERG ET AL.	
	Examiner	Art Unit	
	TIMOTHY PHAM	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 2-13 are objected to because of the following informalities: the limitation "Method of claim" should replace with "The method of claim". Appropriate correction is required.

2. Claims 15-23 are objected to because of the following informalities: the limitation "Mobile telecommunication network" should replace with "The mobile telecommunication network". Appropriate correction is required.

3. Claims 5 and 15 are objected to because of the following informalities: the term "GSM or UMTS" is an acronym which can mean different things and/or change in meaning over time; hence, it would be desirable to write out the actual words to which the acronym refers.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 recites the limitation "the Subscriber Identity Module (SIM) or the Universal Subscriber Identity Module (USIM)". There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the International Mobile Equipment (IMET) number ". There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1, 5, 8, 11, and 23 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 3-4, 10-11 of prior U.S. 2007/0004455, now Patent No. 7,505,786. This is a double patenting rejection.

Claims 1, 3-4, and 10-11 of the U.S. 2007/0004455 as shown in the table below contains every element of claims 1, 5, 8, 11, and 23 of the instant application and, as such, claims 1, 5, 8, 11, and 23 of the instant application claims the same invention as that of the patent.

U.S. 2007/0004455	Instant Application: 10/595941
1. A method in a mobile telecommunication network **for detection of subscriber information**, the network comprising a mobile station with subscriber information, **a repository for storing subscriber** and telephone number information, and means for detecting signals sent from the mobile subscriber terminal, the method comprising:	1. Method in a mobile telecommunication network **for detection of device information** including subscriber information and equipment information, the network comprising a mobile station with a terminal part and with a module for subscriber information and an application, the network further comprising **a repository for storing device information**, the method comprising:

a) **detection of subscriber information of a mobile station attaching to the network,**	a) the application of the mobile station **detecting device information of a mobile station attaching to the network,**
b) **comparing the detected subscriber information with the subscriber** and telephone number information stored in the network, and	b) the application of the mobile station **comparing the detected device information to the device information previously stored in the mobile station**, and
c) **storing the detected subscriber information in the network if it does not correspond to the information previously stored in the network**.	c) the application of the mobile station sending **the detected device information to be stored in the network repository if it does not correspond to the information previously stored.**
3. A method of claim 1**, wherein the network is based on GSM or UMTS.**	5. Method of claim **1 wherein when the network is based on GSM or UMTS**, the module with subscriber information is the Subscriber Identity Module (SIM) or the Universal Subscriber Identity Module (USIM), respectively.
11. A mobile telecommunication network of claim 7, **wherein the repository stores lists of pairs of International Mobile Subscriber Identity (IMSI) numbers and The Mobile Station Integrated Service Digital Network (MSISDN) numbers**.	8. Method of claim 5 **wherein the repository stores lists of pairs of International Mobile Equipment (IMEI) numbers and either or both of International Mobile Subscriber Identity (IMSI) numbers and Mobile Station Integrated Service Digital Network (MSITSN) numbers**.
4. A method of claim 3, **wherein the repository stores lists of pairs of International Mobile Subscriber Identity(IMSI) numbers and Mobile Station**	11. Method of claim 5 **wherein the repository stores lists of pairs of International Mobile Subscriber Identity (IMSI) numbers, Mobile Station Integrated Service Digital Network**

Integrated Service Digital Network (MSISDN) numbers.	**(MSISDN) numbers** and Integrated Circuit Card ID (ICCID) numbers.
10. A mobile telecommunication network of claim 7, **wherein the detector for handling subscriber information is a SIN Switch Detector(SSD)**.	23. Mobile telecommunication network of claim 20 **wherein the detector for handling device information is a SIM Switch Detector (SSD)**.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-3, 5-9, 14-20, 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Pecen et al. (hereinafter "Pecen"; US 2002/0142753).**

Regarding claim 1, Pecen discloses a method in a mobile telecommunication network for detection of device information including subscriber information and equipment information (Abstract; paragraphs [0012], [0030]), the network comprising a mobile station with a terminal part (Fig. 1, reference 102; paragraphs [0014], [0016], e.g., a mobile user device) and with a module for subscriber information and an application (Fig. 1, reference 142, e.g., SIM card), the

network further comprising a repository for storing device information (Fig. 1, reference 150 or 156, e.g., HLR), the method comprising:

a) the application of the mobile station detecting device information of a mobile station attaching to the network (Fig. 1, reference 140; paragraphs [0030], [0036], [0039], e.g., a SIM detector),

b) the application of the mobile station comparing the detected device information to the device information previously stored in the mobile station (paragraphs [0031], [0040]), and

c) the application of the mobile station sending the detected device information to be stored in the network repository (paragraphs [0030]-[0031], [0039], [0040]) if it does not correspond to the information previously stored (paragraph [0040], e.g., if service is not barred, a normal SIM-based call would be routed to HLR 150).

Regarding claim 2, Pecen discloses the method of claim 1 above, wherein the application is situated in the module for subscriber information and is executed by a signal from the operation system of the module for subscriber system when the mobile terminal is switched on (paragraphs [0004], [0012], [0035], [0037]).

Regarding claim 3, Pecen discloses the method of claim 1 above, wherein when detecting equipment information, the application reads the previously stored device information from a memory space in the mobile station from the module with subscriber information and the application requests the detected device information from the terminal of the mobile station (paragraphs [0012], [0030], [0032]-[0033]), the detected information being compared to the previously stored device information (paragraph [0040]).

Regarding claim 5, Pecen discloses the method of claim 1 above, wherein when the network is based on GSM or UMTS (paragraph [0003], [0005], [0014], [0029], [0033]), the module with subscriber information is the Subscriber Identity Module (SIM) or the Universal Subscriber Identity Module (USIM), respectively (Abstract; paragraphs [0011], [0031]).

Regarding claim 6, Pecen discloses the method of claim 3 above, wherein when detecting equipment information, a terminal switch is detected and the application is a Terminal Switch Application (TSD) in the Subscriber Identity Module (SIM) of the mobile station (Fig. 1, reference 140; paragraphs [0030]-[0031], [0036], [0039], e.g., SIM Detector).

Regarding claim 7, Pecen discloses the method of claim 6 above, wherein the device information detected by said terminal switch application consists of equipment information, such as the International Mobile Equipment (IMET) number (paragraph [0013], [0030], [0034], [0036]).

Regarding claim 8, Pecen discloses the method of claim 5 above, wherein the repository (Fig. 1, reference 144) stores lists of pairs of International Mobile Equipment (IMEI) numbers (paragraph [0013], [0030], [0034], [0036]) and either or both of International Mobile Subscriber Identity (IMSI) numbers and Mobile Station Integrated Service Digital Network (MSITSN) numbers (Abstract; paragraphs [0004], [0012], [0030], [0032]-[0034]).

Regarding claim 9, Pecen discloses the method of claim 7 above, wherein when the IMEI value detected does not correspond to the IMEI previously stored on the SIM card it is updated to the SIM card (paragraphs [0013], [0030], [0034]) and sent to be stored in said repository storing pairs of IMEI/IMSI and or MSISDN values (paragraphs [0012]-[0013], [0030], [0034]).

Regarding claim 14, Pecen discloses a mobile telecommunication network for detection of device information comprising: the device information having subscriber information and equipment information (Fig. 1, reference 140; paragraphs [0030], [0036], [0039]i, e.g., a SIM detector), the network having a mobile station with a terminal part and with a module for subscriber information and an application (Fig. 1, reference 102; paragraphs [0014], [0016], e.g., a mobile user device), the network having a repository for storing of device information , the mobile station having an application for detecting device information (Fig. 1, reference 150 or 156, e.g., HLR), the network further having a detector for handling device information (Fig. 1, reference 140; paragraphs [0030], [0036], [0039], e.g., a SIM detector), and a repository for storing device information(Fig. 1, reference 144; paragraphs [0030], [0036], [0039]).

Regarding claim 15, Pecen discloses the mobile telecommunication network of claim 14 above, wherein the network is based on GSM or UMTS (paragraph [0003], [0005], [0014], [0029], [0033]), the module with subscriber information being the Subscriber Identity Module (SIM) or the Universal Subscriber Identity Module (USIM), respectively (Abstract; paragraphs [0011], [0031]).

Regarding claim 16, Pecen discloses the mobile telecommunication network of claim 14 above, wherein the application for detecting device information consists of a device switch application in the Subscriber Identity Module (SIM) of the mobile station (Fig. 1, reference 140; paragraphs [0030]-[0031], [0036], [0039], e.g., SIM Detector).

Regarding claim 17, Pecen discloses the mobile telecommunication network of claim 16 above, wherein the device switch application in the Subscriber Identity Module (SIM) of the

mobile station is a Terminal Switch Application (Fig. 1, reference 140; paragraphs [0030]-[0031], [0036], [0039]).

Regarding claim 18, Pecen discloses the mobile telecommunication network of claim 17 above, wherein the repository stores lists of pairs of International Mobile Equipment (IMPI) numbers (paragraph [0013], [0030], [0034], [0036]) and any or both of International Mobile Subscriber Identity (IMSI) numbers and MSISDN values (paragraph [0013], [0030], [0034], [0036], e.g., IMSI).

Regarding claim 19, Pecen discloses the mobile telecommunication network of claim 14 above, wherein the detector for handling device information is a Terminal Switch Detector (TSD) (paragraphs [0030]-[0031], [0036], [0039], e.g., SIM Detector).

Regarding claim 20, Pecen discloses the mobile telecommunication network of claim 16 above, wherein the device switch application in the Subscriber Identity Module (SIM) of the mobile terminal is a SIM Switch Application (paragraphs [0012], [0030]-[0031], e.g., s SIM detector 140 for detecting the presence of s SIM card 142 within mobile user device 102).

Regarding claim 22, Pecen discloses the mobile telecommunication network of claim 20 above, wherein the Subscriber Identity Module (SIM) contains a variable indicating whether the new IMSI/NSISDN/ICCID information has been stored in the repository (paragraphs [0004], [0012], [0030], [0032]-[0034]).

Regarding claim 23, Pecen discloses the mobile telecommunication network of claim 20 above, wherein the detector for handling device information is a SIM Switch Detector (SSD) (Fig. 1, reference 140; paragraphs [0030]-[0031], [0036], [0039], e.g., SIM Detector).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 4, 10, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pecen in view of Zhao et al. (hereinafter "Zhao"; US 2004/0192251).

Regarding claim 4, Pecen discloses the method of claim 1 above, wherein when detecting equipment information, the detected device information is compared to the device information previously stored in the mobile station (paragraphs [0031], [0040]).

Pecen fails to specifically disclose by means of an indicator, which is read by the application from a memory space in the mobile station, the value of the indicator indicating whether a switch of the module with subscriber information has taken place.

However, Zhao discloses an emergency connection indicator, which is read by the application from a memory space (see Fig. 1, reference 144; paragraph [0030], e.g., a memory) in the mobile station (Abstract; paragraphs [0005], [0030], [0037], [0041]), the value of the indicator indicating whether a switch of the module with subscriber information has taken place (paragraphs [0005], [0030], [0037], [0041]).

Therefore, taking the teachings of Pecen in combination of Zhao as a whole, it would have been obvious to one having ordinary skill in the art at the time of the invention by applicant

to have the detected device information is compared to the device information previously stored in the mobile station, as taught by Pecan, and cooperating by means of an indicator, the value of the indicator indicating whether a switch of the module with subscriber information has taken place, as suggested by Zhao, for advantages of indicating whether there is a new SIM.

Regarding claim 10, Pecen in combination with Zhao, discloses the method of claim 4 above, wherein when detecting subscriber information, a SIM switch is detected and the application is a SIM Switch Application in the Subscriber Identity Module (SIM) of the mobile station (Pecen: paragraphs [0012], [0030]-[0031], e.g., s SIM detector 140 for detecting the presence of s SIM card 142 within mobile user device 102).

Regarding claim 12, Pecen in combination with Zhao, discloses the method of claim 10 above, wherein the device information detected by said SIM switch application is an indicator value indicating whether a SIM switch has taken place (Pecan: paragraph [0031], e.g., SIM detector 140 detects the presence of SIM card 142 within mobile user device 102, and informs interim identity generator 138 when SIM card 142 is not positioned within mobile user device 102).

Regarding claim 13, Pecen in combination with Zhao, discloses the method of claim 12 above, wherein when according to said indicator value, a SIM switch has taken place (Pecan: paragraph [0031]), subscriber information, such as new IMSI/MSISDN/ICCID values, are sent to be stored in said repository storing pairs of IMSI/MSISDN/ICCID values (Pecan: paragraphs [0004], [0012], [0030], [0032]-[0034]) and said indicator value is updated to tell about the SIM switch (Pecan: paragraphs [0031]-[0032]).

10. Claims 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pecen in view of Kjellman et al. (hereinafter "Kjellman"; US 2005/0021787).

Regarding claims 11 and 21, Pecen discloses the method and the Mobile telecommunication network for detection of device information of claims 5 and 14 respectively above, wherein the repository stores lists of pairs of International Mobile Subscriber Identity (IMSI) numbers (paragraphs [0004], [0012], [0030], [0032]-[0034]).

Pecan fails to specifically disclose the repository stores lists of pairs of Mobile Station Integrated Service Digital Network (MSISDN) numbers and Integrated Circuit Card ID (ICCID) numbers.

However, Kjellman discloses the repository stores lists of pairs of Mobile Station Integrated Service Digital Network (MSISDN) numbers and Integrated Circuit Card ID (ICCID) numbers (paragraphs [0014]).

Therefore, taking the teachings of Pecen in combination of Kjellman as a whole, it would have been obvious to one having ordinary skill in the art at the time of the invention by applicant to store Mobile Station Integrated Service Digital Network (MSISDN) numbers and Integrated Circuit Card ID (ICCID) numbers for advantages of updating the new SIM card with relevant data.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMOTHY PHAM whose telephone number is (571)270-7115. The examiner can normally be reached on Monday-Friday; 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent P. Harper can be reached on 571-272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Timothy Pham/
Examiner, Art Unit 2617

/VINCENT P. HARPER/
Supervisory Patent Examiner, Art Unit 2617